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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/727,306
Filing Date: December 03, 2003
Appellant(s): WILSON, DOUGLAS B.

Wayne M. Kennard
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 18, 2010 appealing from the Office action mailed May 13, 2010.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: the appeal in copending parent Application No. 10/720,821 filed on June 18, 2010.

(3) Status of claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 14-28 are pending.

Claims 14-19, 24, **25/14**, and 27 stand rejected.

Claims 20-23, **25/20**, 26, and 28 are withdrawn from consideration as not directed to the elected invention.

This appeal involves claims 14-19, 24, **25/14**, and 27.

(4) Status of Amendments after Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of claimed subject matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of rejection to be reviewed on appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 14-19, 24, 25/14, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Shigeru (JP 4-78769).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence relied upon in the rejection of claims under appeal.

JP 4-78769

Shigeru

March 12, 1992

(9) Grounds of rejection

The following grounds of rejection are applicable to the appealed claims:

Claims 14-19, 24, 25/14, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Shigeru (JP 4-78769 cited by Japanese Patent Office in the IDS filed in copending Application No. 10/720,821)

Claim 14

Shigeru teaches a fatigue relieving/preventing apparatus associated with a steering wheel 2 for controlling a vehicle, comprising:

a first section (at a' in FIG. 2, see Appendix hereinafter "App.") that connects to *an upper one-half* of a peripheral portion of the steering wheel 2; and

a rigid, semi-rigid or flexible, or deformable second section (at 1 in FIG. 2, see App.) that connects to and extends from the first section (App.) at the peripheral portion of the steering wheel 2, the second section (App.) extends from the first section (App.) outward at an angle (see angle α in Fig. 4 in App.) to a plane (App.) across a front face of the steering wheel 2, the second section (App.) for providing resting support for at least a portion (*e.g.*, a hand) of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section (App.) is less than the pressure for deforming the second section (App.) out of

interference with the vehicular operator's ability to operate the steering wheel 2, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 2 when pressure from the portion of the vehicular operator's body on the second section (App.) is equal to or greater than the pressure for deforming the second section (App.) out of interference with the vehicular operator's ability to operate the steering wheel 2. (Shigeru, pp. 2-4 of translation)

Claim 15

The steering wheel 2 includes a steering wheel 2 for controlling at least a nautical vessel, aircraft, or ground transportation vehicle.

Claim 16

The portion of the body supported by the second section includes at least a forearm, wrist, or hand. (Shigeru, abstract)

Claim 17

The first section (App.) extends a length of a predetermined peripheral portion of the steering wheel 2.

Claim 18

The second section (App.) includes at least two second sections (*i.e.*, a first second section and a second second section in App.) that each connected to the first section (App.) at separate locations as seen in FIG. 1.

Claim 19

The first section (App.) is deformable since it is made of a cushion material 8, 9, such as, light weight plastic. (Shigeru, pp. 3 and 4 of translation). On the other hand, "deformable" is a relative term, particularly since virtually anything will be deformed if enough pressure is applied

to it. See “flexibility” and “rigidity” in *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969)

Claim 24

Each first section (App.) is formed integral with the steering wheel 2. It is well settled that the term “integral” is sufficiently broad to embrace construction united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973) and *In re Morris*, 43 USPQ2d 1753, 1757 (CAFC 1997).

Claim 25/14

Each first section (App.) is detachable from the steering wheel 2. (Shigeru, p. 3 of translation)

Claim 27

The first section (App.) is flexible, rigid, or semi-rigid, or non-deformable. (Shigeru, pp. 3 and 4 of translation). *Fredman v. Harris-Hub Co., Inc.*, *supra*.

(10) Response to argument

I. PRINCIPLE OF LAW

As noted from pages 14 and 15 of the Board decision on September 2, 2009:

“A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. See *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).” See also *Verizon Services Corp. v. Cox Fibernet Virginia Inc.*, 94 USPQ2d 1833 (Fed. Cir. 2010).

“A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk.” *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). As stated in *Swinehart*, 439 F.2d at 213:

... where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

II. ANALYSIS

At the outset, Appellant contended that Shigeru’s support 1 is constructed of *rigid*, molded plastic (Brief pp. 9 and 10).

The Examiner respectfully submits that Appellant’s contention is unsupported by substantial evidence in the record. In fact, on the one hand, the term “*rigid*” is not appeared in the translation of Shigeru reference. On the other hand, contrary to Appellant’s subjective conjecture, Shigeru expressly teaches:

“In the internal structure of support 1, molded part 8 is a *light-weight plastic* and relieves fatigue of a portion of the hands in contact with the *cushion material* thereon by covering the hand. A surface material 10 can be made with a cloth or with leather.” (Translation p. 3) (Emphasis added)

“almost all parts are formed into curved surfaces and are covered all over with *flexible cushion 9* when they are fixed to steering wheel 2.” (Translation pp. 3 and 4) (Emphasis added)

Thus, Shigeru reference as a whole discloses that the support 1 is flexible cushion, *i.e.*, it is not *rigid*, molded plastic as evidenced from the quotation above. Please see MPEP § 2143.03.

Assuming *arguendo* that Shigeru's support 1 is *rigid*, molded plastic as alleged, the Examiner respectfully submits that Shigeru's support 1 still "reads on" the claimed element "*a rigid, semi-rigid or flexible, or deformable second section*" in claim 14. Put differently, Appellant's tandem arguments relied on the alleged "*rigid*, molded plastic" are unavailing due to the fact that Appellant's appealed claim 14 itself broadly covers such *rigid*, molded plastic material.

Second, Appellant asserted that Shigeru reference teaches away from the present invention. (Brief p. 11)

As noted from MPEP § 2131.05, it is well settled that "Arguments that the alleged anticipatory prior art is 'nonanalogous art' or 'teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not 'germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)).

Third, Appellant asserted that Shigeru does not teach or suggest the present invention for the same reasons the Board found in the Board decision on September 2, 2009 that the present invention was not anticipated by US 2,118,540 (Van Arsdel) or US 1,575,828 (Laubach). (Brief p. 11)

The Examiner respectfully submits that Appellant apparently overlooked the reasons the Board found that the present invention was anticipated by US 2,134,020 (Anson) on pages 18-20 of the above decision.

In the instant case, similarly to Anson, the Board should find that Examiner has clearly found that Shigeru prefers to use a *flexible* cushioning composition/material to form the grip portion 1 that the Examiner is utilizing to read on the second structural aspect as seen in the rejection. An article of manufacture made from a cushioning *flexible* composition would inherently have a capability to deform out of interference. The amount of deformation out of interference would be dependent upon the resilience property of the cured light-weight plastic and not its form. Appellant tries to show that Shigeru does not inherently possess the characteristic of deforming out of interference because the grip would either not be used in operation (*i.e.*, the grip would not be locked or fixed in place and not movable from that place until the locking or fixing tension was removed) (Brief p. 12), or would be dangerous to operate (Brief p. 13), or would not achieve the recited benefits (*i.e.*, deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel) (Brief p. 16). Neither argument outweighs the explicit disclosure that Shigeru's device is manufactured from a material that is *flexible* and thus would have an inherent property of being deformable.

In summary, in this case, the Examiner has good reason to believe that the functional limitation (deforming out of interference) asserted to be critical in establishing novelty in the claimed subject matter, is, in fact, an inherent characteristic of Shigeru's steering attachment. In such a case, the Appellant must provide evidence that Shigeru's steering attachment is not capable of deforming out of interference. See *Swinehart*, 439 F.2d at 213. Arguments that focus on a particular envisioned use of a device in a particular driving condition is not evidence that the device is not inherently capable of deforming out of interference. As such, Appellant has not met his burden of showing that Shigeru's steering attachment is not capable of deforming out of interference as set forth in claim 14. Hence, claims 15-19, 24, 25/14, and 27 fall with claim 14.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

CONCLUSION

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Appeal conference on July 12, 2010:

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